

### **REMARKS**

This paper is a response to the non-final Office Action of June 23, 2010. Prior to entry of this paper, claims 29-50, 58, and 65-78 were pending in this application. Claims 29-50, 58, and 75-78 are being cancelled without prejudice. Claims 67 and 72 are being amended to change matters of form. Claims 83-143 are being newly added. No new matter is added.

In the Office Action mailed June 23, 2010, pending claims 29-50, 58, and 65-78 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

- (A) claims 29-50 and 65-78 were rejected under 35 U.S.C. § 102 as allegedly anticipated by U.S. Patent No. 5,708,709 ("Rose"); and
- (B) claims 29-50, 58, and 65-78 were rejected under 35 U.S.C. § 103 as allegedly unpatentable over a combination of Rose and U.S. Patent No. 5,790,664 ("Coley").

These rejections are respectfully traversed.

### **Examiner Interview**

The undersigned greatly appreciates Examiner Winter's courtesies and assistance during the telephonic Examiner Interview of Nov. 10, 2010, and the follow up telephone call of Nov. 11, 2010. During these conversations, the undersigned and Examiner Winter discussed various issues related to this application. The issues discussed during these conversations are noted below in turn.

The undersigned inquired as to the Election/Restriction discussion on pages 2 and 3 of the Office Action. Examiner Winter indicated that despite the language of the Office Action, the present Office Action does not include an election or restriction

requirement. Instead, the Election/Restriction discussion was included to confirm the Response to Restriction Requirement filed on Mar. 10, 2010, which elected group I (claims 29-50, 58, and 65-78) and cancelled all claims of the unelected group (claims 51-57, 59-64, and 79-82).

The undersigned also inquired as to the status of the Information Disclosure Statements (IDSs) filed on Dec. 23, 2009 and on Mar. 10, 2010. The undersigned noted that the "Transaction History" tab on PAIR shows that a number of IDSs were considered. However, the undersigned has not received copies of the SB/08 (or similar) forms signed by Examiner Winter. The signed forms are also not available on PAIR. Examiner Winter agreed to enter the signed forms into the record by way of a miscellaneous paper. If it is more convenient for Examiner Winter to instead fax or email the signed forms to the undersigned, the undersigned would be glad to make these signed forms of record in this application.

The parties also discussed the 35 U.S.C. § 102 rejection of claims 29-50 and 65-78. With respect to this rejection, Examiner Winter clarified that he did not accord patentable weight to the digital-content-accessing component and licensing component of the various system claims as these components could be software. The undersigned noted that the "manner in which a claimed *apparatus* is intended to be used" (*see, e.g.*, page 4 of the Office Action, emphasis added) rational used in the 35 U.S.C. § 102 rejection was not applicable to computer-readable medium or method claims. Examiner Winter then indicated that the 35 U.S.C. § 102 rejection of computer-readable medium claims 65-70 and method claims 71-74 was due to a clerical error.

With respect to the 35 U.S.C. § 103 rejection of claims 29-50, 58, and 65-78, the undersigned argued that the Office Action failed to state a *prima facie* obviousness rejection. In particular, the undersigned argued that the proffered rational to combine Rose with Coley "to yield a useful product" was unsupported and not a valid reason for combining Rose with Coley. The undersigned also argued that the applied references

failed to disclose or suggest features of the various claims, e.g., "a license component that is incorporated within a component of the digital content" of claim 29.

During the follow up conversation of Nov. 11, 2010, Examiner Winter stated that he located an additional reference of potential relevance to the various claims. This reference, U.S. Patent No. 5,260,999 ("Wyman"), is concurrently listed in an Information Disclosure Statement filed herewith.

A. Response to Rejections under 35 U.S.C. § 102

As noted above, claims 29-50 and 65-78 were rejected under 35 U.S.C. § 102 as allegedly anticipated by Rose.

Without conceding the merits this rejection, it is respectfully submitted that the 35 U.S.C. § 102 rejection of system claims 29-50 and 75-78 is moot in light of their cancellation herewith. The right to pursue these claims in unamended or other form in this application or in a continuing application is reserved.

Withdrawal of the 35 U.S.C. § 102 rejection of computer-readable medium claims 65-70 and method claims 71-74 is respectfully requested in light of Examiner Winter's above-discussed acknowledgement that this rejection of the computer-readable medium claims and method claims was due to a clerical error.

B. Response to Rejections under 35 U.S.C. § 103

Claims 29-50, 58, and 65-78 were rejected under 35 U.S.C. § 103 as allegedly unpatentable over a combination of Rose and Coley.

Without conceding the merits this rejection, it is respectfully submitted that the 35 U.S.C. § 103 rejection of system claims 29-50 and 75-78 is moot in light of their cancellation herewith. The right to pursue these claims in unamended or other form in this application or in a continuing application is reserved.

With respect to the 35 U.S.C. § 103 rejection of claims and 65-74, it is respectfully submitted that the Office Action fails to state a *prima facie* obviousness rejection because the Office Action fails to provide a clear articulation of the reasons why Rose is combined with Coley. In relevant part, MPEP § 2142 states (with added emphasis):

"[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396. (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Also under MPEP § 2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

In the present case, the Office Action fails to provide a clear articulation of reasons why Rose is combined with Coley. Rather, the Office Action alleges "[i]t would be obvious to one having ordinary skill in the art at the time the invention was made to combine Rose ('709)'s teaching with the Coley et al. ('664) method in order to enable the transaction to yield a useful product." (See, e.g., pages 6, 9, and 11 of the Office Action.) The Office Action fails to provide articulated reasons and rational underpinnings or even any additional reasons to support the combination of Rose with Coley. Instead, the Office Action's allegation that it would have been obvious to combine Rose with Coley to "yield a useful product" is merely a conclusory statement that cannot support a *prima facie* obviousness rejection.

Moreover, the Office Action fails to explain what is meant by "a useful product" or to even allege that such a product was in the prior art. Given the lack of explanation for

the meaning of “a useful product[,]” the undersigned can only assume that “a useful product” refers to the present application and the rejected claims thereof – thus evidencing use of improper hindsight. (See, e.g., MPEP 2145(X)(A).)

For at least the above discussed reasons, it is respectfully submitted that the Office Action fails to state a *prima facie* obviousness rejection of claims 65-74. Accordingly, the 35 U.S.C. § 103 rejections of claims 65-74 should be withdrawn.

#### New Claims 83-143

Newly added claims 85-143 are allowable over the present rejections for at least reasons similar to those discussed above. Further, newly added claims 83-143 are fully supported by the present application, e.g., by figures 3, 4, and 8 and pages 6-7 and 13-17 of the as-filed disclosure.

#### Conclusion

In view of the foregoing, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 622-1711 if the Examiner believes that an interview might be useful for any reason. It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper.

However, if additional extensions of time are necessary, such extensions of time are hereby petitioned under 37 CFR 1.136(a). If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: Dec. 15, 2010

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